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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,017	08/06/2003	John Butler	08203.0005-03	7577
22852	7590	10/18/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/635,017	BUTLER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Anu Ramana	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 July 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 52-73 is/are pending in the application.  
 4a) Of the above claim(s) 56, 64-66 and 70-73 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 52-55, 57-63 and 67-69 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 23 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/688,138.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/23/03; 7/28/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Election/Restrictions***

Applicants' election of Species 5 (Figures 33-40) in the response filed on July 28, 2006 is noted. Accordingly, claims 52-55, 57-63 and 67-69 have been examined in this office action and claims 56, 64-66 and 70-73 have been withdrawn from further consideration because they are directed to non-elected species.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 52-55, 57 and 60-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 26 of copending Application No. 10/678,653 ('653 herein) in view of Crook (US 5,524,644).

Claim 26 of '653 discloses all elements of the claimed invention except for a distal ring and a generally cylindrical sleeve.

Crook teaches an incision liner having a cylindrical sleeve extending between proximal and distal rings for ease of adjustability.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a generally cylindrical sleeve in claim 26 of '653

extending between proximal and distal rings, as taught by Crook, for ease of adjustability.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 52-55, 57, 60, 62 and 63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 61 of copending Application No. 10/374,523 ('523 herein).

Regarding claims 52-55 and 57, although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claim of the copending application is that the claim the copending application include many more elements and are thus more specific. Thus the invention of the claims of copending application is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claim of the copending application, they are not patentably distinct from the claim of the copending application.

Regarding claims 60 and 62-63, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the distal ring of a resilient material or the proximal ring of a material having a low coefficient of friction, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 52-55, 57-63 and 67-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 27 of U.S. Patent No. 6,254,534 (Butler et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the present application and the patented claims is that the patented claims are more specific. Thus the invention of the patented claims is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the patented claims, they are not patentably distinct from the patented claims.

Claims 52-55, 57 and 60-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,582,364 (Butler et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the present application and the patented claim is that the patented claim is more specific. Thus the invention of the patented claim is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the patented claim, they are not patentably distinct from the patented claim.

Regarding claims 62 and 63, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the distal ring of a resilient material or the proximal ring of a material having a low coefficient of friction, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

October 16, 2006

